

REMARKS

Reconsideration of the present application is respectfully requested.

The allowance of claims 1-8 and the indication of allowability for claim 12 is acknowledged with appreciation.

The rejection of claims 9-11 under 35 U.S.C. § 103 as being unpatentable over Shimote et al. (5,212,677) in view of Sliger (5,745,313) is respectfully traversed.

Claim 9 features the step of defining parameters with reference to the reference location. Neither Shimote et al. nor Sliger teach or suggest that feature.

Shimote et al. teach a defect lists in Figs. 24 and 30. However, those defects lists do not include parameters that are defined with reference to a reference location. Nowhere do Shimote et al. teach or suggest that Size, Class, Track, Angle and/or R are defined with reference to a reference location. That's because Shimote et al. nowhere disclose the selection of a reference sector. This lack of teaching and suggestion is confirmed from the Office Action by its reliance on Sliger to disclose the selection of a reference sector.

The Office Action contends that the "first sector" taught in col. 5, line 10, is the same as the claimed reference sector. Assuming arguendo that this is correct, Sliger does not teach or suggest the step of defining parameters with reference to the reference location. The cited disclosure in Sliger that the Office Action relies on is misplaced. That disclosure teaches the first sector contains a Boot Record. The Boot Record is disclosed as containing fields to describe the physical and logical geometry of the diskette, and information that describes the characteristics of the drive, including, for example, the number of bytes per sector and the number of sectors per cluster, the number of sectors per track. Yet Sliger does not teach or suggest that those fields or information are defined with reference to the reference location.

Therefore, even if there were a motivation to combine these two references, that combination would lack the step of defining parameters with reference to the reference location. The combination's lack of that step results in claim 9 not being obvious in view of the two applied references, and is thus allowable. Claims 10-11 are also allowable because of their dependency on allowable claim 9.

For an entirely separate reason, claim 9 is not obvious and allowable. The Office Action states that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to improve upon Shimote et al.'s invention with the teaching Sliger in order

to maximizing the data storage capacity of a diskette." That reasoning is flawed for at least two reasons.

First, Shimote et al. discloses a defect list for a non-diskette storage device. So maximizing the data storage capacity of a diskette is irrelevant. Sliger already shows that. What is missing is any objective evidence that would lead a skilled artisan to modify the Shimote et al. defect list with the first sector described in Sliger.

Second, there is no reasoning based on objective evidence that shows that one skilled in the art *would* be led by the statement "for maximizing the data storage capacity of a diskette" to modify the Shimote et al. defect list with the first sector disclosed in Sliger. For example, the Office Action does not provide any objective evidence that one skilled in the art has specific knowledge that would lead her to modify Shimote et al. as suggested by the Office Action just from the Sliger purpose of "maximizing the data storage capacity of a diskette." Nor does the Office Action provide any objective evidence that the Sliger purpose of "maximizing the data storage capacity of a diskette" is linked to using the first sector as disclosed in Sliger or that using the first sector would be applicable to defect lists. Absent such objective evidence, the rejection of claims 9-11 cannot be supported.

For similar reasons, new claims 14-17 are also allowable over the two applied references.

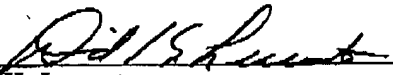
Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

SEAGATE TECHNOLOGY LLC
(Assignee of Entire Interest)

Date

11/10/04


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